

## **REMARKS**

Claims 2, 4-8, and 10-25 are pending in the application with claims 2, 4-8, 10, and 11 being withdrawn as directed to a nonelected species. In the Office Action mailed December 2, 2009, claims 2, 4-8, 10, 11, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 12-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,529,968 (Sartin, herein after referred to as “Sartin”). Claims 12-25 are further rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,489,291 (Henschke et al., herein after referred to as “Henschke”).

### **I. Amendments and Response to Rejections under 35 U.S.C. 112, second paragraph**

Claims 2, 4-8, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite because they depend from cancelled claims. The Applicant has herein cancelled claims 2, 4-8, 10, and 11, thus rendering this rejection moot.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because it allegedly is unclear “which mechanism is the one used for ‘connecting said first spring to said second spring at a predetermined time in said gate cycle’” and the recited limitation “a predetermined time” is allegedly “vague and confusing.” The Applicant has herein cancelled claim 25, thus rendering this rejection moot.

### **II. Amendment and Response to Rejections under 35 U.S.C. 102(b)**

Claims 12-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sartin. The Applicant respectfully traverses the rejections. With respect to independent claim 12, claim 12 is not anticipated by Sartin because Sartin fails to teach all of the Applicant’s claim limitations.

In the Applicant’s claimed invention, the knee and ankle are operationally coupled by means of the claimed first and second springs (“anterior spring (k)” and “posterior spring (f)”) in such a manner that movement of the knee or ankle causes movement in the other element, affording a transfer of energy from hip muscular work to ankle powered plantar-flexion work by storing and releasing energy in the springs in order to first extend the lower leg and then to increase the bearing force applied to the ground by the toe during ankle plantar-flexion. This configuration removes the need for a motor and power supply at the ankle and consequently

lowers the metabolic cost associated with accelerating the legs during walking [Specification as published at least at paragraphs [0028], [0044], and [0065] and in Fig. 7].

In contrast, Sartin teaches only an ankle with two attached springs and a knee with an attached spring, which knee and ankle are operationally uncoupled. To the extent that the knee and ankle of Sartin happen to move at the same time, it is simply coincidental due to the external force caused by contact of the foot with the ground. Sartin fails to teach an actively coupled knee-ankle configuration, as is claimed by the Applicant.

It is well-established that “all the words in a claim must be considered in judging the patentability of that claim against the prior art” (MPEP 2143.03, citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970), emphasis added). It is not sufficient that the Office Action merely cite a reference teaching something alleged to have a generally similar structure or functionality, the reference must teach each and every one of the Applicants’ claimed limitations, wherein all of the words in the claim are given effect. Further, for anticipation, “the prior art reference- in order to anticipate under 35 U.S.C. 102- must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim’” (Net MoneyIn v. Verisign, 545 F.3d 1359 (Fed. Cir. 2008)). When reversing a finding of anticipation based on an erroneous jury instruction that stated “for anticipation, it is sufficient if the single reference would have informed those skilled in the art that all of the claimed elements could have been arranged as in the claimed invention” (emphasis added), the Federal Circuit has recently stated, “[t]he requirement that the prior art elements themselves be ‘arranged as in the claims’ means that claims cannot be ‘treated … as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.’” (emphasis added, *Therasense, Inc. (Abbott) v. Becton, Dickinson and Co.* (Fed. Cir. 2010), quoting *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984)).

In the Office Action, the teaching of Sartin is applied to the Applicant’s claimed elements without reference to the operational relationships between those elements and their functional behavior, even stating explicitly that the device of Sartin “is capable of being used as claimed if one so desires to do so”. It is clear to one of ordinary skill in the art, as well as from the Applicants’ Specification, that the mechanism of Sartin is both structurally and operationally different from the Applicant’s claimed invention. It is further clear that the mechanism of Sartin is not actually capable of “being used as claimed” and that the Applicant’s claims have been

“treated as a mere catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims, and that weight has not been given to “all the words in the claims”, as is required. Reconsideration and withdrawal of the rejection of independent claim 12 under 35 U.S.C. 102(b) as being anticipated by Sartin is therefore respectfully requested.

Furthermore, in order to more particularly point out and claim that, in the Applicant’s invention, the functional recitations impart structural limitations to the Applicant’s claimed invention, which structural limitations are not taught by Sartin or any art of record, the Applicant has herein amended independent claim 12 to specifically recite that the various claimed elements are “configured for” their claimed operational characteristics. Support for this amendment is found in the Specification as published at least at paragraphs [0028], [0044], and [0065]-[0066], and in Fig. 7. No new matter is added by this amendment, entry of which is respectfully requested. The amendment makes it clear that the operational characteristics of the Applicant’s claimed invention impart structural limitations to the claims, limitations which are not taught by Sartin or any other art of record.

Independent claim 12, as amended, is not anticipated by Sartin because, as discussed above, Sartin fails to teach an actively coupled knee-ankle configuration, and thus Sartin fails to teach all of the Applicant’s claimed limitations. Because Sartin fails to teach all of the limitations claimed by the Applicants in independent claim 12, Sartin fails to anticipate or make obvious the Applicants’ claimed invention, whether taken alone or in combination with any other art of record. Reconsideration and withdrawal of the rejection of independent claim 12 under 35 U.S.C. 102(b) as being anticipated by Sartin is therefore respectfully requested.

Because claims 13-24 depend from currently amended independent claim 12, which is not anticipated by Sartin and is in condition for allowance as discussed in the foregoing, claims 13-24 are also not anticipated by Sartin and in condition for allowance. Reconsideration and withdrawal of the rejection of dependent claims 13-24 as being anticipated by Sartin is therefore respectfully requested.

Claims 12-25 are further rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Henschke. The Applicant respectfully traverses the rejections. With respect to independent claim 12, as amended, is not anticipated by Henschke because Henschke also fails to teach all of the Applicants’ claimed limitations.

As discussed above, in the Applicant’s invention, the knee and ankle are operationally coupled by means of the claimed first and second springs in such a manner that movement of the

knee or ankle causes movement in the other element, affording a transfer of energy from hip muscular work to ankle powered plantar-flexion work. by storing and releasing energy in the springs in order to first extend the lower leg and then to increase the bearing force applied to the ground by the toe during ankle plantar-flexion. In particular, in the Applicant's claimed invention, the toe is lowered during ankle plantar-flexion, as the bearing force applied to the ground is increased. [Specification as published at least at paragraph [0065] and in Fig. 7 (stage (6) and (7))].

In contrast, Henschke teaches the opposite: that, while the knee of Henschke might be operationally coupled to the ankle, the toe of Henschke moves upward as the knee begins to bend at the beginning of ankle plantar-flexion [Henschke at least at col.7, lines 59-73, and especially lines 64-69]. The device of Henschke is thus completely different operationally from the device disclosed and claimed by the Applicant. Henschke therefore fails to teach that the toe is lowered during ankle plantar-flexion, increasing the bearing force applied to the ground, as is claimed by the Applicant in currently amended independent claim 12.

Independent claim 12, as amended, is therefore not anticipated by Henschke because, as discussed above, Henschke fails to teach all of the Applicant's claim limitations. Because Henschke fails to teach all of the limitations claimed by the Applicants in independent claim 12, Henschke fails to anticipate or make obvious the Applicants' claimed invention, whether taken alone or in combination with any other art of record. Reconsideration and withdrawal of the rejection of independent claim 12, as amended, as being anticipated by Henschke under 35 U.S.C. 102(b) is therefore respectfully requested.

Because claims 13-24 depend from currently amended independent claim 12, which is not anticipated by Henschke and is in condition for allowance as discussed in the foregoing, claims 13-24 are also not anticipated by Henschke and in condition for allowance. Reconsideration and withdrawal of the rejection of dependent claims 13-24 as being anticipated by Henschke is therefore respectfully requested.

### **III. New claims**

New claims 26-34, all directed to the previously-elected species, have been added. Support for these new claims is found in the Specification as published at least at paragraphs [0028], [0044], [0045], and [0065]-[0068], and in Figs. 7 and 8. No new matter is added by these new claims, entry of which is therefore respectfully requested.

#### **IV. Conclusion**

Claims 2, 4-8, 10, 11, and 25 have been cancelled. Claims 12, 13, 15, 17, 18, and 21-24 have been amended. New claims 26-34 have been added. No new matter is added by these amendments and new claims, entry of which has been respectfully requested. The Applicant respectfully submits that claims 12-24 and 26-34 are now in condition for allowance, which action is now requested. Should there remain any unresolved issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicant's Attorney, at 603-437-4400, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,



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